REMARKS

This is in response to the Office Action dated April 8, 2005. Reconsideration is respectfully requested.

Request for Extension of Time

Applicants respectfully request that the time period for response to the Action be extended three months, from July 8, 2005 to October 11, 2005 (October 8 being a Saturday, October 10 being a holiday). Enclosed is Credit Card Form PTO-2038 authorizing the charge of $510 in payment of the three-month extension fee pursuant to 37 CFR 1.17(a)(3).

Summary of the Rejections

Claims 1-3 are pending in the application. Claims 1 and 2 are rejected as obvious over Japanese Patent Publication JP 404285511 A to Nomura in view of information item AR, listed in the Information Disclosure Statement filed by applicants on September 24, 2003, disclosing a Cal Spas' web page depicting a Cal Spas "Lounger" (hereafter the "Cal Spas design").

Claim 3 is rejected as obvious over Nomura in view of the Cal Spas design, and further in view of U.S. Patent No. 5,758,200 to Inoue et al.

Summary of the Invention

The invention (hereafter the "Master Spas design") concerns a sealing system for safely positioning electronic equipment proximate to a body of water. The sealing system includes a surface that extends substantially horizontally and proximate to the water. An aperture is positioned in the surface. A water-tight housing adapted to hold the electronic

equipment is positioned in alignment with the aperture. The housing is movable between a first position beneath the surface and a second position projecting above the surface. The housing has a top that is larger in size than the aperture. The top includes a sealing area facing the surface. The sealing area is engageable with the surface to effect a seal around the perimeter of the aperture to keep water from the housing interior when the housing is positioned beneath the surface.

The Argument

Applicants respectfully traverse the rejection of Claims 1-3 on the basis of obviousness, contending that the information item disclosing the Cal Spas design is not a valid reference because the Cal Spas design is a copy of the Master Spas design, the Master Spas design being an original design that predates the Cal Spas design.

In conjunction with this reply, applicants submit a copy of a declaration of prior invention pursuant to 37 CFR 1.131. This declaration was filed in response to an Office Action dated September 20, 2004 for Application No. 10/671,646, entitled "Combination Spa and Entertainment System". The rejections encountered in the Office Action of September 20 are based upon the same references as those in the present Action of April 8, 2005. Furthermore, the '646 application is a continuation of Application No. 10/286,280, and the present application is a divisional of this same application. Therefore, the enclosed declaration is believed to present evidence relevant to the present application. If required by the Examiner, applicants will re-submit the declaration specific to the instant application.

The declaration is that of Terry M. Valmassoi, a co-inventor of the Master Spas design recited in Claims 1-3, and Executive Vice President of Master Spas, the assignee of the present application.

In the declaration, Mr. Valmassoi states that the Master Spas design was shown to selected associates of Master Spas (a group of 30 sales representatives and key Master Spas dealers) at a confidential executive council meeting held at the Master Spas' factory in Fort Wayne, Indiana, in June of 2000. The Master Spas design was subsequently introduced to the pool and spa industry at the National Spa and Pool Industry (NSPI) Tradeshow, held at the Orange County Convention Center in Orlando, Florida, during November of 2000. Mr. Valmassoi personally attended the show and visited the Cal Spas exhibit. The Cal Spas design, as depicted in the information item cited as a reference in this action, was not on display at this time.

Mr. Valmassoi first saw the Cal Spas design some three months later, at the Aqua Tradeshow, held at the Las Vegas Convention Center on February 6, 2001 in Las Vegas, Nevada. Mr. Valmassoi believes that the Cal Spas design was not in production at that time, and further believes that production models of the Cal Spas design were not available for delivery to dealers until late spring of that year.

In view of the extreme closeness of the Cal Spas design to the Master Spas design, some features of which appear identical, and with the knowledge that the Master Spas design was confidentially shown to selected Master Spas associates more than eight months before the appearance of the Cal Spas design, and shown to the public more than three months before

the appearance of the Cal Spas design, one can only conclude that the Cal Spas design was copied from the Master Spas design based upon information obtained either from the executive council meeting (in violation of confidentiality agreements and understandings) or at the aforementioned NSPI tradeshow. As a copy derived from the Master Spas design, the Cal Spas design and information items disclosing it, cannot be a valid reference supporting and obviousness rejection of any of applicants' claims.

In response to applicants' submission of the declaration in the related '646 application, the Examiner considered the showing of the Master Spas design of June 5, 2002 to sales representatives and dealers as "use or sale" because "no evidence of any confidentiality has been presented and the use of the 'working prototypes' was not restricted to the mere enjoyment of the inventor". The Examiner further maintains that this showing of the Master Spas design renders it unpatentable under 35 USC 102(b) because the effective filing date of the application is more than one year after June 5, 2002.

Applicants respectfully assert that, in requiring the presentation of "evidence of confidentiality", the Examiner is not applying the proper criteria in evaluating applicant's declaration under Rule 131. The MPEP, in Section 715.07 states, "The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the facts. FACTS, not conclusions must be alleged. Evidence, in the form of exhibits may accompany the affidavit or declaration." emphasis added).

Applicants assert that the declaration meets the aforementioned criteria because facts, and not conclusions, are alleged therein. Point 5 of the declaration alleges the fact that a working prototype of the Master Spas design was shown on June 5, 2000. It further alleges the fact that the design was shown at the Master Spas factory, the showing was to selected associates and was confidential. There are no conclusions presented, only facts. However, the Examiner has chosen to accept some of the facts without any corroborating evidence, while requiring evidence for other facts alleged. The Examiner accepts that there was a showing of the Master Spas design on June 5, 2000, but requires evidence that the showing was confidential. The MPEP clearly states that evidence "may" accompany the declaration, but nowhere does it require such evidence be presented.

In support of his assertion that the June 5, 2000 showing constituted "use or sale", the Examiner also stated that the use of the working prototype was not "restricted to the mere enjoyment of the inventor". Applicants note that the prototype referred to was under development at the Master Spas factory as alleged in the declaration and, therefore, not in public use. The idea that the prototype was not "restricted to the mere enjoyment of the inventor" has no relevance and cannot properly support an allegation of public use since the prototype was not in use, but still under development at the factory. As alleged in point 6 of the declaration, work continued on the Master Spas design between June and November of 2000 when production units were ready.

Further with respect to the Examiner's assertion that the showing of the Master Spas design in June of 2000 "falls within the sale criteria of this statute" (35 USC 102(b)),

applicants note that the Examiner does not cite any authority in support of this conclusion. The aforementioned showing was the confidential display of a prototype of the Master Spas design to selected representatives for informational purposes; no orders were solicited or taken at the showing. The prototype was still under development at the time of the showing and had not yet received UL approval. Such a showing does not constitute an offer for sale under 35 USC 102(b).

In support of this assertion, applicant cites Linear Technology Corp. v. Micrel Inc., 61 USPQ2d 1225 (Fed. Cir. 2001), which stands for the proposition that it takes more than a mere showing to constitute an offer for sale under 35 USC 102(b). In Linear, the lower court found a patent invalid in view of an on-sale bar that consisted of (among other activities engaged in by the patentee) dissemination of information at a sales conference attended by its domestic and international sales representatives. The appeals court reversed the finding of invalidity, stating that it was clear that "the conference did not make offers for sale but rather laid the necessary groundwork for future offers." Id. at 1231. Linear further makes clear that "only an offer which rises to the level of a commercial offer for sale, one which the other party could make into a binding contract by simple acceptance (assuming consideration), constitutes an offer for sale under 102(b)." Id. at 1229. Because there were no solicitations or acceptance of offers for sale during the June 2000 showing of the prototype of the Master Spas design at the Master Spas factory, it cannot reasonably be concluded that the showing constitutes an offer for sale that falls under 35 USC 102(b) in view of the cited authority.

Applicants further note that the allegations made in the declaration are made with the knowledge that willful false statements are punishable by fine and imprisonment, and potential loss of patent rights. This knowledge alone provides significant weight to the probity of the facts alleged, and applicants, therefore, contend that the facts alleged constitute a sufficient showing that the Cal Spas information does not constitute a proper reference on which to reject applicants' claims and further demonstrate that the showing of the prototype does not constitute a use or sale under 35 USC 102(b).

Applicants respectfully request, in view of the evidence presented in the declaration, that the Cal Spas information item be eliminated as a reference, the rejections be withdrawn, Claims 1-3 be allowed and the application passed to issue.

Respectfully submitted,

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Enclosures

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